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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,457	09/11/2000	Henrik Sune Andersen	5956.200-US	9106

23650 7590 01/26/2005

NOVO NORDISK, INC.  
PATENT DEPARTMENT  
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EXAMINER

SAEED, KAMAL A

ART UNIT PAPER NUMBER

1626

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/662,457

Applicant(s)

ANDERSEN ET AL.

Examiner

Kamal A Saeed

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 110-221 is/are pending in the application.

4a) Of the above claim(s) 127, 129, 131, 135-137, 139, 141, 151, 153, 155, 159-161, 163, 165, 171, 174, 175, 178-180, 182, 184, 203, 205, 207, 211-213, 215, 217, 142, 166, 185 and 21 is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) See Continuation Sheet is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims objected to are 73,110-126,128,130,132-134,138,140,143,150,152,154,156-158,162,164,167-169,172,176,177,181,186-202,204,206,208-210,214,216 and 219-221.

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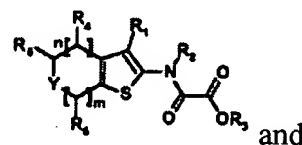
***DETAILED ACTION***

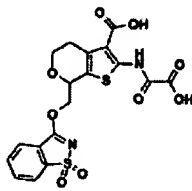
Claims 1-109 have been cancelled. Therefore claims, 110-221 are currently pending in the instant application. Claims 127, 129, 131, 135-137, 139, 141, 151, 153, 155, 159-161, 163, 165, 171, 174, 175, 178-180, 182, 184, 203, 205, 207, 211-213, 215, 217, 142, 166, 185 and 218 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

***Response to Restriction***

Applicants' election of claims of Group I, claims 110-126, 128, 130, 132-134, 138, 140, 143, 150, 152, 154, 156-158, 162, 164, 167-169, 172, 73, 176, 177, 181, 186-202, 204, 206, 208-

210, 214, 216 and 219-221 are drawn to products of the formula (I),



specific compound ,  , in response filed on October 11, 2004 is acknowledged.

Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Therefore, the restriction requirement is deemed proper.

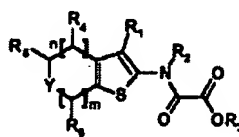
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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Status of the Claims*

Claims 1-109 are pending in this application. Claims 110-126, 128, 130, 132-134, 138, 140, 143, 150, 152, 154, 156-158, 162, 164, 167-169, 172, 73, 176, 177, 181, 186-202, 204, 206, 208-210, 214, 216 and 219-221 (all claims in part), and 127, 129, 131, 135-137, 139, 141, 151, 153, 155, 159-161, 163, 165, 171, 174, 175, 178-180, 182, 184, 203, 205, 207, 211-213, 215, 217, 142, 166, 185 and 218 as previously stated, are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

The scope of the invention of the elected subject matter is as follows:



Compounds of formula I, depicted in claim 110, wherein:

**Y** is as defined; **R<sub>1</sub>** is as defined except it does not represent a heterocyclic group; **m** and **n**, are as defined; **R<sub>2</sub> – R<sub>5</sub>** are as defined except that they do not represent a heterocyclic ring; **R<sub>6</sub>** is an alkylheteroaryl group. As a result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 110-126, 128, 130, 132-134, 138, 140,

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143, 150, 152, 154, 156-158, 162, 164, 167-169, 172, 73, 176, 177, 181, 186-202, 204, 206, 208-210, 214, 216 and 219-221 are withdrawn from further consideration pursuant to 37 CFR 1.142

(b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as , piperidine, thiopiran, pyran, pyrrole etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classifications of these functional groups in the U.S. classification system, i.e. class 546 subclass 249(+) (piperidine), class 548 subclass 400(+) (pyrrole), class 549 subclass 1(+) (thiopian) etc. Therefore the subject matter which are withdrawn from consideration as being non-elected subject differ materially in structure and composition and have been restricted properly a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

### ***Objections***

Claims 110-126, 128, 130, 132-134, 138, 140, 143, 150, 152, 154, 156-158, 162, 164, 167-169, 172, 73, 176, 177, 181, 186-202, 204, 206, 208-210, 214, 216 and 219-221 are objected to for containing elected and non-elected subject matter. It is suggested that the claims be amended to be limited to the elected invention as identified supra.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed whose telephone number is (571) 272-0705. The examiner can normally be reached on M-T 7:30 AM- 5:00 PM.

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Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

Kamal Saeed  
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